

## **REMARKS/ARGUMENTS**

Reconsideration and withdrawal of the rejection of the application are respectfully requested in view of the remarks herein, which place the application into condition for allowance.

### **I. STATUS OF THE CLAIMS AND FORMAL MATTERS**

Claims 1-19 and 21-22 are currently pending. Claims 1, 3-5, 10, 13, 16, and 21-22 are independent.

### **II. REJECTIONS UNDER 35 U.S.C. 112**

Claims 1-19, 21, and 22 were rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. The Office Action asserted independent claims 1, 3-5, 10, 13, 16, and 21-22 the limitation, “. . . to force the display of first and second advertisement . . . substantially at the same time,” “. . . force a viewer to view said first and second ad [sic] . . . before . . .” are not disclosed in the specification.

Applicants respectfully traverse this rejection.

A. As a preliminary matter not all the independent claims recite the elements noted in the Office Action. Therefore, the §112 rejection of each independent claim must be assessed separately.

1. Claims 16, 21, and 22 **do not** recite the limitation, “substantially at the same time” or

“ . . . force a viewer to view . . . before . . .”

2. Only claims 5, 10, and 13 recite the limitation, “. . . force a viewer to view said first and second ad [sic] . . . before . . .”

**B.** The limitation, “. . . to force the display of first and second advertisement . . . substantially at the same time,” is disclosed in the specification as follows:

First, claim 1 is representative and recites the “to force the display of said first advertisement-associated data . . . and second advertisement-associated data.” Support for forcing display of the first and second advertisement data as recited in claim 1 is found in Publ App. par. [0141]. *See, also*, Publ. App. pars. [0003]-[0004]:

“Accessing the iEPG site, the user of the personal computer 1 can acquire the preset-recording data free of charge. However, in return for the free preset-recording data, the user is forced to view an advertisement in viewing the television program recorded by use of the preset-recording data.

The advertisement the viewer “is forced to view” are the first and second advertisement-associated data. This is as clearly shown in FIG. 23, which illustrates first and second advertisements in windows 271 and 272. The areas are described in the Publ. App. pars. [0163]-[0165]. Acquisition of the first and second advertisement-associated data is described throughout the specification, and for this purpose, in Publ. App. pars. [0148]-[0154] and FIGS. 18 and 19.

Claims 16, 21 and 22 thus overcome the 112 rejection because this is the only element rejected in the Office Action that is recited in those claims.

Second, claims 1, and 3-5, recite the additional feature that the first and second advertisement-associated data are displayed, “substantially at the same.” Support for this feature is found in Publ. App. pars. [0166]-[0167] and FIG. 23:

“It should be noted that, as long as the image of the AV content 151 being reproduced is displayed in the AV content recording/reproducing window 180, the advertisement windows 271 and 272 cannot be closed. Therefore, when the user of the personal

computer 1 views the AV content 151 generated by the preset recording executed in accordance with the settings based on the preset-recording data, he also views the advertisement displayed at the same time.

Also, it should be noted that the advertisement windows 271 and 272 may be opened when the AV content recording/reproducing window 180 is closed to display the image corresponding to the animation GIF file included in the first and second advertisement-associated data.”

Thus, the user forced to view the first and second advertisement-associated data at substantially the same time because when said user views the AV content, the user also views the advertisement displayed in window 271 at the same time. Moreover, the advertisements in windows 271 and 272 are the first and second advertisement associated data.

Thus, claims 1, and 3-5 also overcome the 112 rejection.

C. Claims 5, 10, and 13 recite the feature, “. . . force a viewer to view said first and second advertisement-associated data . . . before . . . receiving said preset-recording data.” Support for this feature is found in the Publ App. par. [0141]. *See, also*, Publ. App. pars. [0003]-[0004]:

“Accessing the iEPG site, the user of the personal computer 1 can acquire the preset-recording data free of charge. However, in return for the free preset-recording data, the user is forced to view an advertisement in viewing the television program recorded by use of the preset-recording data.

and, in Publ App. par. [0179]:

“Thus, in the second operation example, an advertisement is displayed before the preset-recording data is obtained (downloaded). Further, an advertisement is also displayed when a program recorded on the basis of the obtained preset-recording data is reproduced for viewing.” (emphasis added).

Thus, the user is forced to view the first and second advertisement-associated data and the advertisement-associated data is displayed before receiving the preset-recording data.

Thus, claims 5, 10, and 13 overcome the 112 rejection.

### III. REJECTIONS UNDER 35 U.S.C. 103

Claims 1-4, 16-19, 21 and 22 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Application Publication No. 2002/0046407 to Franco (hereinafter, merely “Franco”) in view of U.S. Patent No. 6,536,041 to Knudsen (hereinafter, merely “Knudsen”) and further in view of U.S. Patent No. 6,588,015 to Eyer et al. (hereinafter, merely “Eyer”) and Official Notice;

Claims 5-15 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Franco, Knudsen and Eyer and further in view of U.S. Patent No. 6,704,929 to Ozer et al. (hereinafter, merely “Ozer”) and also under Official Notice.

Applicants respectfully traverse these rejections.

As stated in the present Office Action at page 2, par. 3, the amended claim limitations made in Applicants February 8, 2008 have not been considered. Applicants have overcome the §112 rejections without amendment and request consideration of the amendments on the merits.

Claim 1 is representative and recites, *inter alia*:

“... receiving means for receiving said preset-recording data, keyword data, and first advertisement-associated data from said information providing apparatus in response to said television program identifying information and second advertisement-associated data from said information providing apparatus in response to said keyword data;

...  
... force the display of said first and second advertisement-associated data substantially at the same time to force a viewer to playback said first and second advertisement-associated data while simultaneously playing back said television program.” (Emphases added)

Applicants respectfully submit the combination of Franco, Knudsen, Eyer and Ozer does not teach the above-recited feature of claim 1. In particular, in an aspect of the present invention,

two advertisements are received in response to transmitting a request for the preset-recording data. A first advertisement is responsive to program identifying information. A second advertisement is responsive to the keyword data. Moreover, both the first and second advertisements are displayed at the same time while the television program is also being played back.

In an example from the specification, a program to be recorded is identified by the recording date and channel data received. The advertisement site sends the first advertisement-associated data supplied by a sponsor who purchased the corresponding advertisement frame on the television program based on the recording date/time and channel data. Publ. App. pars. [0150]-[0152] and FIG. 19.

Also, the advertisement site matches the program keyword to a second advertisement based upon a relationship managed by the advertisement site. Publ. App. par. [0156] and FIG. 22.

By executing the above-mentioned advertisement-associated data acquisition processing, the first advertisement is related to the program date/time/channel purchased by the sponsor of the program. The second advertisement is related to the keyword associated with the program.

Both the first and second advertisements are displayed at the same time on the screen along with the television program. Publ. App. par. [0163] and FIG. 23.

The above-described feature is not described in the combination of Franco, Knudsen, Eyer and Ozer.

For reasons similar, or somewhat similar, to those described above with regard to independent claim 1, independent claims 3-5, 10, 13, 16, and 21-22 are also patentable.

#### IV. REJECTIONS OF CLAIMS UNDER OFFICIAL NOTICE

Claims 6-7, 11-12, 14-15 and 17-18 were rejected under Official Notice.

Claims 6-7, 11-12, 14-15 and 17-18 depend from one of the independent claims discussed herein above and are believed patentable for at least the same reasons.

Moreover, Applicants contend the Office Action impermissibly relies on Official Notice and fails to respond to Applicants' challenge under MPEP 2144.03(C).

APPLICANTS CHALLENGE THE FACTUAL  
ASSERTIONS AS NOT PROPERLY OFFICIALLY  
NOTICED OR NOT PROPERLY BASED UPON  
COMMON KNOWLEDGE.

- In Applicants' January 25, 2007 reply to the Office Action mailed October 20, 2006, Applicants challenged the factual assertions of the Official Notice taken. The next Office Action mailed April 19, 2007 failed to address Applicants' challenge.

- In Applicants' July 18, 2007 reply to the Office Action mailed April 19, 2007 Applicants again challenged the factual assertions of the Official Notice taken. The present Office Action also fails to address Applicants' challenge.

- In Applicants' February 8, 2008 reply to the Office Action mailed September 13, 2007 Applicants again challenged the factual assertions of the Official Notice taken. The present Office Action also fails to address Applicants' challenge.

Applicants' challenge to the Official Notice is recited in the replies mailed January 25, 2007 and July 18, 2007 and not reiterated here, but said challenge is incorporated herein by reference.

## **V. DEPENDENT CLAIMS**

The other claims are each dependent from one of the independent claims discussed above, and are therefore patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

## **CONCLUSION**

All claims are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference(s), it is respectfully requested that the Examiner specifically indicate those portion(s) of the reference(s), providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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